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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/692,950

10/27/2003

Kentaro Fujino

244405US0X

2139

22850

7590

01/07/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

KNABLE, GEOFFREY L

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

01/07/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/692,950	Applicant(s) FUJINO ET AL.	
	Examiner Geoffrey L. Knable	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-21 and 23-30 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/23/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1791

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/2008 has been entered.

2. Claims 19-21 and 23-30 are allowable. The restriction requirement between inventions/species A, B and C, as set forth in the Office action mailed on 3/22/2006, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claim 27 has therefore been rejoined with the allowance of generic claim 24. Claim 12, which (if dependent upon current generic claim 24) required all the limitations of an allowable claim, previously withdrawn from consideration as a result of the restriction requirement, was canceled by applicant in the reply filed on April 24, 2006. The canceled, nonelected claim may be reinstated by applicant if submitted in a timely filed amendment in reply to this action. Upon entry of the amendment, such amended claim(s) will be examined for patentability under 37 CFR 1.104.

In view of the withdrawal of the restriction requirement as set forth above, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or

Art Unit: 1791

nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. Note: As the allowed claims are directed to a pneumatic tire, it is suggested that the title be amended for consistency with the allowed claims.

4. Claims 19-21 and 23 -30 are allowed.

The claims are allowed for the reasons advanced by applicant in the remarks accompanying the October 23, 2008 amendment, the following added for emphasis.

Among the closest prior art, Lin et al. (US 5,292,590) discloses a tire with an innerliner formed from an ethylene vinyl alcohol copolymer that preferably contains less than 50% ethylene content and is more than 90% saponified (esp. col. 3, lines 53-63). Modification by reacting with a monofunctional epoxy compound or cross-linking as claimed is not however taught. JP 2002-79804 (cited by applicant in 10/23/2009 IDS) discloses a tire including a cross-linked ethylene-vinyl alcohol copolymer innerliner, as well as an auxiliary/intermediate layer, but does not teach or render obvious a modified ethylene-vinyl alcohol copolymer modified by reacting with a monofunctional epoxy compound as claimed.

JP 63-8448 (a translation of this reference was provided by applicant on 4-24-2006) discloses a high oxygen barrier film material formed by reacting EVOH, having preferably 25-70 mol % ethylene (page 5 of translation) and examples of 25% and 40% (page 20), with for example 5% of an epoxy compound (e.g. glycidyl allyl ether - pages

Art Unit: 1791

21-25) to improve various film properties. Specific application as a tire innerliner is not however taught in this reference.

In the specification, comparative data is presented (esp. Table 1) showing the superiority of the tires formed with a modified ethylene-vinyl-alcohol innerliner consistent with the claimed invention as compared to tires with unmodified EVOH, especially with regard to the ability to retain pressure after driving. In particular, these results illustrate important improvements in pressure retainability after driving, results that would not have been expected or predicted from the prior art such as JP '448 directed to modified EVOH films in general.

In light of these comparative results suggesting an unexpected benefit accompanies providing a tire with an innerliner comprising a layer comprising a modified ethylene-vinyl alcohol consistent with the claims, as well as the closest prior art not specifically motivating the ordinary artisan to provide a tire with a modified ethylene-vinyl alcohol copolymer innerliner as claimed, the closest prior art fails to suggest or render obvious a pneumatic tire as claimed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1791

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/
Primary Examiner, Art Unit 1791

G. Knable
January 4, 2009